

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue Application of:

ROGER J. LEYDEN ET AL

Ser. No.: 08/807,120
(U.S. Pat. 5,552,771, issued 9/13/96)

Filed: 2/19/97



RETRACTABLE SENSOR
FOR AN ALARM SYSTEM

Art Unit: 2617

Examiner: A. Wong

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231
Sir:

This is a response to the Final Office Action dated September 19, 2000.

Claims 1-14 remain pending. All claims stand rejected under 35 USC §103 as obvious over U.S. Patent No. 5,341,124, to Leyden et al (Leyden), in view of U.S. Patent No. 4,989,805 (Burke) and U.S. Patent No. 5,124,685 (Rankin). Reconsideration of the rejection of claims 1-14 is requested.

In making a rejection based on obviousness, there must be some motivation, suggestion, or teaching to make the combination of prior art proposed by the Examiner. It appears that the Examiner has recognized that the motivation, suggestion, or teaching does not come explicitly from the cited prior art. The Examiner has not referred to any portion of any of the three cited references wherein such a suggestion is alleged to exist. Accordingly, it is the applicant's understanding that the Examiner's position is that the teaching, motivation, or suggestion is implicit from the prior art, rather than being expressed therein. The Examiner asserts that the motivation for combining the prior art

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results from "common sense". The applicant respectfully submits that what the Examiner attributes to common sense is rather a product of hindsight.

This is a situation where simplicity may lure one into an inappropriate assertion of obviousness. The applicant will readily admit that retraction of conductive and non-conductive cables has long been known. Most everyone has had the experience of watching a mechanic work with a trouble light that is suspended from a ceiling mount and having a power carrying cord that is selectively retracted onto a reel and extended to set a desired length. Burke is cumulative to this type of prior art.

As the attached Declaration of Messrs. Reese and Passuntino confirm, the industry struggled for years to solve the problem of "wire management". In spite of the industry's knowledge of different devices with retracting cables, effective wire management in the security field was accomplished only after the introduction of Se-Kure Controls' product that is claimed in the above-identified application.

Leyden, which is the principal reference cited by the Examiner, was invented by the same inventors herein. That system, while highly effective in terms of its security, makes no provision for wire management.

As a preliminary matter, it is significant to note that the assignee of the present invention, and also the assignee of the Leyden patent relied upon by the Examiner, has been in the business of designing, manufacturing, and selling security products, including a wide range of products specifically designed for portable consumer goods at point of purchase for over 30 years (See Attachment 1 to Mr. Passuntino's Declaration). As can

be seen from the representative 1991 catalog for Se-Kure Controls' products, (See pages 2-5 and 9 of Attachment 2 to Mr. Passuntino's Declaration), Se-Kure Controls has, since as early as 1991, been heavily involved in the design, manufacture, and sale of electrically operated security systems utilizing conductive cables. Mr. Passuntino notes, in paragraphs 10 and 13 of his Declaration, that wire management is a key in the design of all such security systems. Effective wire management involves minimizing the amount of exposed wire while allowing objects connected thereto to be moved freely about for inspection by potential purchasers. At the same time, aesthetic considerations and customer convenience must not compromise the overall security of the system.

The history of the claimed invention will now be described through the evidence in the Declarations of Messrs. Passuntino and Reese. The development of displays for one of Se-Kure's large accounts, Wal-Mart, is described in Mr. Passuntino's Declaration. These displays use the basic Leyden technology with alarm systems using conductive wire to connect to electronic sensors attached to products to be monitored (see Passuntino Declaration ¶¶11, 14). Mr. Passuntino was in communication with Wal-Mart during the development of these displays by Se-Kure. Wire management was a "key consideration" in the design of these systems (see Passuntino Declaration ¶13). The first display for Wal-Mart using the Leyden technology was developed in early 1995 and is shown on page 1 of Attachment 3 to Mr. Passuntino's Declaration (See Passuntino Declaration ¶11). The display was designed for numerous cameras which were connected to a central alarm system through separate conductive wires. To minimize wire exposure, the wires were

directed through a shelf for connection to the alarm system. A weight was separately attached to each wire to cause it to be drawn through the shelf and out of sight (See Passuntino Declaration ¶¶14 and 15). The requirement of the weight was burdensome. The overall system layout had drawbacks which Wal-Mart complained of (See Passuntino Declaration ¶¶16 and 25).

Mr. Passuntino notes that he was in communication with representatives of Wal-Mart on behalf of Se-Kure and received requests for an alternative system that was easier to set up and which had better wire management capabilities (See Passuntino Declaration ¶22). Mr. Passuntino also noted that it was Se-Kure's general practice, as part of its ongoing research and development, to address complaints such as Wal-Mart's and seek alternative designs (see Passuntino Declaration ¶25). This led to the development of the system shown in Attachment 4 to Mr. Passuntino's Declaration (See Passuntino Declaration ¶16).

The system of Attachment 4 to Mr. Passuntino's Declaration retracted a mechanical cable to thereby reposition an electrical cable. This system required that both a mechanical and an electrical cable be "managed" (See Passuntino Declaration ¶18). Se-Kure continued to receive complaints regarding the system of Attachment 4 (See Passuntino Declaration ¶19).

In short, Se-Kure worked diligently on wire management in a system such as that in Leyden for Wal-Mart from 1995 to 1997, at which time the claimed invention was made available to Wal-Mart (see Passuntino ¶22). The claimed system overcame the problems

in the system of Attachments 3 and 4 to Mr. Passuntino's Declaration and was adopted by Wal-Mart to replace all of its existing security systems (see Passuntino Declaration ¶¶21 and 23).

In summary, Mr. Passuntino supports in his Declaration that the Leyden system was desirable in terms of its operating characteristics. However, because each product was separately connected by a conductive wire, wire management was a significant issue. Over the course of approximately two years, Se-Kure and Wal-Mart sought out viable wire management solutions. The two attempted solutions of Attachments 3 and 4 to Mr. Passuntino's Declaration were not acceptable to either Se-Kure or Wal-Mart. Se-Kure's solution to the wire management problem occurred only when the claimed invention was developed. Prior to that time, Se-Kure and its customers dealt with the inconveniences associated with ineffective wire management.

Further evidence of the wire management problem appears in the attached Declaration of Mr. Reese. Mr. Reese has held the position of Maintenance Supervisor at Long Drug Stores for in excess of 15 years (See Reese Declaration ¶1). Long Drug Stores currently has approximately 435 stores (see Reese Declaration ¶3).

Mr. Reese explains that Long Drug Stores initially utilized what it believed to be the best product, in terms of electronic security, in the early 1990 time frame, that being one sold by Vulcan as shown in U.S. Patent No. 5,124,685. This is the secondary "Rankin" patent relied upon by the Examiner herein (See Reese Declaration ¶¶12-14).

Mr. Reese recognized that the Vulcan product was relatively easily defeatable. However, the Vulcan product was installed in virtually all Long Drug Stores and used continuously for years (See Reese Declaration ¶¶15-19). In spite of the thefts resulting from the Vulcan product, Long Drug Stores continued to use the Vulcan product because it was not aware of the existence of a viable alternative system.

As soon as Mr. Reese became aware of the Se-Kure system as claimed herein, Long Drug Stores converted their security systems in all their stores and continues to use the same to this day (See Reese Declaration ¶¶24-26).

Mr. Reese has been in a position which demands that he investigate and select security systems that are both effective and which do not add significant aesthetic problems associated with wire management. Mr. Reese struggled to solve the wire management problem for Long Drug Stores. In spite of this effort, Long Drug Stores contended with years of convenience, and dealt with losses attributable to an ineffective system, due to the fact that no viable alternative was known to Mr. Reese.

If, as the Examiner suggests, it would be nothing more than common sense to combine the devices in the cited prior art to arrive at the claimed structure, certainly the claimed invention would have been arrived at earlier, given the industry's effort to develop a highly effective security system with good wire management capabilities. Se-Kure, which is heavily involved in the design of security products for consumer goods, together with Mr. Reese, collectively have decades of experience in this industry. Yet, all struggled to arrive at a system that was effective from a security standpoint and one which did not introduce

significant wire management problems. The solution did not surface for years after the problem of wire management was center stage. Se-Kure actually went through several permutations of the system before it arrived at the claimed design, which process took place over the course of years.

In short, the conclusion made by the Examiner with respect to obviousness is inconsistent with what actually occurred in the industry. The claimed structure is not obvious without the benefit of hindsight using applicant's claimed structure as a template. The Federal Circuit, in In re Kotzab, 55 USPQ 2nd, 1313 (CAFC 2000) clearly stated the test for a proper rejection based on obviousness.

Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto . . . broad conclusory statements standing alone are not evidence. (at page 1317)

As the Kotzab court further stated:

[A] rejection cannot be predicated on the mere identification in Evans of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. (at page 1317)

No particular finding has been made by the Examiner as to the reason a skilled artisan would have combined the components in the cited art to arrive at the claimed invention. The Examiner only refers to "common sense" as the motivation. However, the industry has borne out that "common sense" did not direct those highly skilled in this area to arrive at the claimed invention, as they struggled with the existing problems for years.

It is respectfully submitted that the Examiner has not made out a *prima facie* case of obviousness. Accordingly, withdrawal of the rejection of claims 1-14 and allowance of the case are requested.

Respectfully submitted,



John S. Mortimer, Reg. No. 30,407

WOOD, PHILLIPS, VANSANTEN,
CLARK & MORTIMER
500 W. Madison St., Suite 3800
Chicago, IL 60661
(312) 876-1800

Date: Dec 19, 2000

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CERTIFICATE OF MAILING

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